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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,764	10/24/2003	Stephen C. P. Joseph	57764US005	2185
32692	7590	08/12/2009		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER KIM, CHRISTOPHER S	
			ART UNIT 3752	PAPER NUMBER
			NOTIFICATION DATE 08/12/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/693,764

**Applicant(s)**

JOSEPH ET AL.

**Examiner**

Christopher S. Kim

**Art Unit**

3752

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 4, 8-38 and 45-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7 and 39-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date 1/21/09/3/9/09
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The response filed May 6, 2009 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Election/Restrictions*

3. Applicant elected without traverse Group I, Species F (Figure 16) in the reply filed on November 13, 2007.
4. Claims 4, 8-38 and 45-64 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 13, 2007.

In the reply filed on September 2, 2008, applicant indicated that claims 8, 9, 11-13, 20, 21 and 35 are readable on the elected species.

Claim 8 recites "...the reservoir has an outlet opening to a connector tube integral with the reservoir, and the connector tube is received in the socket..." in lines 1-2. The feature is only found in the non-elected Species A (figure 5). In elected Species F (figure 16), the connector tube 485, 480 is not integral with the lid of the reservoir 402. Connector tube 485 is connected to the lid of reservoir 402 by flange 422 and hook members 416, 417. Claims 9, 11-13, 20 and 21 depend on claim 8. If the "connector

tube" of Species F (figure 16) is in reference to the equivalent element of connector tube 15, the connector tube of Species F is not received in an integral socket of the spray gun.

### ***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "connector boss is a separate piece that is permanently secured to the body of the spray gun" recited in claim 7; the "air vent" recited in claims 41 and 44; the "disposable container" recited in claim 42; the "inner container" recited in claim 43 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: integral connector; co-operating connector means.

***Claim Rejections - 35 USC § 112***

7. Claims 2, 3, 5, 6, 7, 40, 41, 43, 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the outlet of the lid includes a connector tube, and the connector tube is received within the socket" in lines 2-3. It appears to be a double inclusion of the "co-operating connector means" recited in claim 1.

Claim 5 recites the limitation "an integral connector boss" in line 2. It appears to be a double inclusion of the "integral connector" recited in claim 1.

Claim 40 recites the limitation "a rigid pot" in line 1. It appears to be a double inclusion of the "container" recited in claim 1.

Claim 43 recites the limitation "an outer container" in lines 1-2. It appears to be a double inclusion of the "container" recited in claim 1.

Claim 43 recites the limitation “an inner container” in line 2. It appears to be a double inclusion of the “disposable container” recited in claim 42.

***Claim Rejections - 35 USC § 102***

8. Claims 1-3, 5-7, 39, 40, 41 are rejected under 35 U.S.C. 102(b) as being anticipated by McRitchie (3,236,459).

McRitchie discloses a liquid spraying apparatus comprising:

a spray gun 10;

a reservoir comprising:

a container 18;

a removable lid 12;

the spray gun having integral connector 46;

a cooperating connector means 48 (connector tube) on the lid 12.

Claim 7 appears to be a product by process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

9. Claims 1-3, 5, 7, 39-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Joseph et al. (WO 98/32539).

Joseph discloses a liquid spraying apparatus comprising:

a spray gun 1;

a reservoir 11 comprising:

a container 12;

a removable lid 15;

the spray gun having integral connector 21;

a cooperating connector means 18 on the lid 15;

a connector tube 17;

an inner container 13.

Claim 6 is evidence that the term "integral connector boss" does not require the integral connector boss and the spray gun to be one piece.

Regarding claim 7, the recitation "permanently secured" is a functional recitation that merely requires the ability to so perform. The integral connector boss 21 of Joseph is permanently secured to the body of the spray gun if it is never removed.

***Claim Rejections - 35 USC § 103***

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al. (WO 98/32539).

Joseph discloses the limitations of the claimed invention with the exception of the integral connector boss and the body of the spray gun being one piece.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the integral connector boss and the body of the

spray gun one piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

### ***Response to Arguments***

11. Applicant's arguments filed January 26, 2009 have been fully considered but they are not persuasive.

Regarding withdrawn claim 8, Applicant argues that element 485 is incorrectly characterized as the "connector tube" of claim 8. Intervening claim 2 recites the limitation "the outlet of the lid includes a connector tub", and the connector tube is received within the socket." Therefore, the "connector tube" must include adaptor 485 and/or insert 480 which is received in socket 421.

Regarding applicant's arguments directed to the drawing objections, applicant points to figures of non-elected species showing the claimed features.

Applicant's arguments directed to the prior art is moot in light of the new reading of McRitchie and Joseph as detailed above.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (571) 272-4905. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571) 272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher S. Kim/  
Primary Examiner, Art Unit 3752

CK